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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,494	01/30/2004	Achim Melching	87333.3321	5036

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EXAMINER
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RAMDHANIE, BOBBY

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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01/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/767,494	<b>Applicant(s)</b> MELCHING ET AL.	
	<b>Examiner</b> BOBBY RAMDHANIE	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1 and 3-27 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejections have been necessitated by Applicants' amendments to the claims.
2. Applicant's arguments, see Remarks, filed 11/11/2008, with respect to the Double Patenting Rejection have been fully considered and are persuasive. The rejection of Double Patenting has been withdrawn.

### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 11/11/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US7013197 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 3-13, and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over MALIN in view of BATHE (US6536859).

7. Applicants' claims are toward a device.

8. Regarding Claims 1, 3-13, and 21-27, MALIN discloses the climatic cabinet, comprising:

9. A). A plurality of walls defining a utilization space (See figure 1a Item 2), one wall having at least one transfer opening with a respective door (See Figure 1a Item 210 & Figure 4b Item 15), the transfer opening providing access to the utilization space (See Figures 1a & 4b); B). At least one specimen storage device, disposed within the utilization space, including a plurality of storage locations (See Figure 1b Item 650 or Figure 1a Items 8); C). At least one inner transport device, disposed within the utilization space, to transport specimen slides to and from the specimen storage device (See Figure 1b Item 620); F). An outer transport device, disposed outside the utilization space, to transport specimen slides to and from the buffer specimen storage device and to establish a transport connection with the transfer opening such that a specimen slide is transported between the buffer specimen storage device, the inner transport device,

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and the specimen storage device (See Figure 4a).; and E). A buffer specimen storage device, disposed outside the utilization space (See Figure 5a Item 100, & [0083]). MALIN does not disclose explicitly that the buffer storage device included a plurality of storage locations. BATHE however, discloses a buffer storage device which explicitly discloses a plurality of storage locations (See (Figure 1 & Column 2 line 3 note the words "storage magazines"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the climatic cabinet of MALIN with the climatic cabinet of BATHE because according to MALIN, the external conveyor system (See MALIN Item100) can comprise an automatic transport system for the objects.

10. Additional Disclosures Included: Claim 3: The buffer specimen storage device for use with a climatic cabinet in accordance with Claim 1, wherein the buffer specimen storage device is designed as a separate unit that can be detachably connected via a coupling device to the climatic cabinet (See MALIN Figure 5a Items 151 & 152); Claim 4: The climatic cabinet according to Claim 1, wherein the buffer specimen storage device comprises at least one specimen slide cassette (See Column 2 lines 4, microtiter plates may define specimen slide cassettes); Claim 5: The climatic cabinet according to Claim 3, wherein the buffer specimen storage device comprises several specimen storage cassettes in a carousel arrangement (See (Figure 3 & Column 3 lines 34-37); Claim 6: The climatic cabinet according to Claim 1, wherein the outer transport device comprises a vertically movable lift (See Figure 1) and a horizontally movable shifting unit (See Figure 2); Claim 7: The climatic cabinet according to Claim 1, wherein the transfer location for a specimen is located between the outer and the inner transport

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device in the area of the transfer opening (See MALIN Figure 4A & [0072]); Claim 9: The climatic cabinet according to Claim 1, wherein the buffer specimen storage device and the outer transport device are arranged in a housing with a service opening (See Figure 1 Item 22 & Column 2 lines 14-18, large door); Claim 10: A buffer specimen storage device with an outer transport device and housing for use with a climatic cabinet according to Claim 9, wherein the buffer specimen storage device is designed as a separate unit that can be detachably connected to the climatic cabinet via a coupling device (See MALIN Item 100); Claim 11: The climatic cabinet according to Claim 1, wherein a device is present for the pre-air-conditioning of the buffer specimen storage device and/or of the outer transport device (See MALIN Figure 6b Item 642 & BATHE See Column 2 lines 10-18); Claim 12: The climatic cabinet according to Claim 1, wherein the device for pre-air-conditioning is designed as a blower (See MALIN Figure 6b Item 642); Claim 13: The climatic cabinet according to Claim 1, wherein the device for pre-air-conditioning is controlled as a function of an actuation of the service opening (See MALIN [0094] & Figure 4b & 6b);

11. For Claims 21-26, the combination of MALIN and BATHE disclose the climatic cabinet, comprising: A). A plurality of walls defining a utilization space (See MALIN Figure 1 Item 2), one wall having a closable transfer opening providing access to the utilization space (See Figure 4b Item 15); B). A first means for storing specimen slides, disposed within the utilization space (See MALIN Figure 1b Item 650 or Figure 1a Item 8); C). A first means for transporting specimen slides, disposed within the utilization space, to convey specimen slides between the first means for storing and the transfer

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opening (See Figure 1b Item 620); D). A second means for storing specimen slides, disposed outside the walls (See MALIN Figure 4a or BATHE, Figure 1); and E). A second means for transporting specimen slides, disposed outside the walls, to convey specimen slides between the second means for storing and the transfer opening, the first and second means for transporting cooperating together to exchange specimen slides within the transfer opening (See BATHE, Figure 1); Claim 22: The climatic cabinet according to Claim 21, wherein the second means for storing is detachably connected to the wall having the transfer opening (See MALIN Figure 5a Item 100); Claim 23: The climatic cabinet according to Claim 21, wherein the second means for storing is a specimen slide carousel (See BATHE Figure 1); Claim 24: The climatic cabinet according to Claim 21, wherein the second means for storing and the second means for transporting are disposed within a housing having a service opening (See BATHE Figure 1 & Column 2 lines 14-18); Claim 25: The climatic cabinet according to Claim 24, further including a means for temperature conditioning the specimen slides disposed within the housing (See Column 2 lines 10-18); and Claim 26: The climatic cabinet according to Claim 21, wherein the second means for transporting includes a vertically-movable lift (See Figure 1) and a horizontally-movable shifting unit (See BATHE; Figure 2).

12. For Claim 27, the combination of MALIN and BATHE disclose the climatic cabinet according to Claim 21, except wherein the wall has a plurality of transfer openings through which the specimen slides are exchanged.

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13. For Claims 8 & 27, the combination of MALIN and BATHE disclose the climatic cabinet according to Claims 1 & 21, except including a plurality of transfer openings by which a plurality of specimen storage devices are loaded by a plurality of inner transport devices, wherein the outer transport device has an operative connection to the transfer openings. The combination of MALIN and BATHE does however disclose the singular form of the plurality of devices. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a plurality of transfer openings by which a plurality of specimen storage devices are loaded by a plurality of inner transport devices, wherein the outer transport device has an operative connection to the transfer openings., since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Telephonic Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOBBY RAMDHANIE whose telephone number is (571)270-3240. The examiner can normally be reached on Mon-Fri 8-5 (Alt Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. R./

/Walter D. Griffin/  
Supervisory Patent Examiner, Art Unit 1797